

include transitory signals and carrier waves, which are non-statutory subject matter. The Examiner suggests amending the term “computer readable medium” to recite “non-transitory computer readable medium.”

Applicant respectfully submits that the Examiner’s interpretation of the term “computer readable medium” as including transitory signals and carrier waves is incorrect, and notes that this interpretation contradicts rulings by the Board of Patent Appeals and Interferences (BPAI) as to how this term should be interpreted.

Specifically, the BPAI has held that unless the specification defines the term “computer readable medium” to include non-statutory media (e.g., propagating electromagnetic signals), then the term should be interpreted to include only statutory media. For example, in *Ex parte Mazzara* Appeal No. 2008-4741 (BPAI Feb. 5, 2009) (non-precedential), the tribunal held that because the specification did not expressly state that the term computer readable medium is intended to include non-statutory subject matter, that term was directed to only statutory subject matter. Specifically, the tribunal stated:

In the present case, there is no express statement in the Specification, nor any other indication in the record, that the term ‘computer usable medium’ is intended to include non-statutory subject matter such as signals or paper. Accordingly, we find that the term ‘computer usable medium’ is limited to only tangible manufactures. As such, claim 17 is directed to statutory subject matter.

Similarly, in *Ex parte Azuma* Appeal No. 2009-003902 (BPAI Sept. 14, 2009) (non-precedential), the tribunal reversed the Examiner’s §101 rejection of claims directed to computer readable media, finding that because the only examples of computer readable media provided in the Specification are tangible computer readable media, the proper interpretation of the term computer readable medium includes only statutory media. Specifically, the tribunal stated:

Thus, based upon the Specification as a whole, we find that Appellant’s description of a ‘computer usable medium’ is based upon *tangible storage media*, such as a server, floppy drive 109, main memory 103 and hard disk 105 as specified by Appellant (App. Br. 4; FF 2, 3 (emphasis added)).

We find that the Examiner erred in finding that the cited claims implicate the user of carrier waves that embody a machine executable program or data structure. Therefore, since the Appellant's independent claim 13 is limited to being recorded on a (*tangible*) computer-readable medium, we reverse the Examiner's rejection of independent claim 13 under 35 U.S.C. §101 as being directed to non-statutory subject matter, as well as that of dependent claim 19.

As in *Mazzara* and *Azuma*, the specification of the present application does not define the term "computer readable medium" to include non-statutory subject matter. Rather, the only examples provided in the specification of computer-readable media are tangible media. Specifically, at page 23, line 31 – page 24, line 3, the specification states, "[i]n this respect, it should be appreciated that one implementation of the embodiments of the present invention comprises at least one computer-readable medium (e.g., a computer memory, a floppy disk, a compact disk, a tape, etc.) encoded with a computer program... (emphasis added).

As such, it is improper to interpret the term "computer readable medium" in claims 21-32, 34-40, 80-88, and 90-96 to include transitory signals or carrier waves. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. §101 be withdrawn.

#### **Rejections Under 35 U.S.C. §103**

The Office Action rejects claims 1-12, 14-32, 34-54, 56-67, 69-71, 73-84, 86-88, 90-104, 106-109, and 110-116 under 35 U.S.C. §103(a) as purportedly being obvious over Heil (6,173,374) in view of Nakayama (2005/0005066), and rejects claims 68, 85, and 105 under 35 U.S.C. §103(a) as purportedly being obvious over Heil, Nakayama, and Iskiyan (5,428,796). For the reasons discussed below, each of these rejections is respectfully traversed.

In Applicant's previous response, Applicant pointed out that each of independent claims 1, 21, 41, 63, 80, and 97 includes limitations that relate to the unit of data being accessible in the storage environment by a content address that is based, at least in part, upon at least a portion of the content of the unit of data, and noted that neither Heil nor Nakayama discloses or suggests that data is accessible using this particular type of address.

In response to this argument, the Examiner does not appear to disagree that the cited references fail to disclose the use of an address for a unit of data that is based, at least in part, upon at least a portion of the content of the unit of data, but rather asserts that the limitations in each of claims 1, 21, 41, 63, 80, and 97 that require that the content address is based, at least in part, upon at least a portion of the content of the unit of data should not be given patentable weight because they appear in the preamble. Applicant respectfully disagrees that these limitations should not be given patentable weight.

MPEP §2111.02 states, “[t]he determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case.” While the Office Action cites two CCPA cases that state that a preamble is generally not accorded patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness, the Office Action makes no attempt to apply this statement of the law to any of the claims and does not provide any analysis as to why the Examiner believes the limitations at issue in the preambles of claims 1, 21, 41, 63, 80, and 97 are not accorded patentable weight. Rather, the Examiner’s rejection appears to be based on a blanket assertion that preambles are never limiting. This assertion contradicts Federal Circuit precedent, which states that the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case. Catalina Mktg. Int’l v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed. Cir. 2002). If the rejection is to be maintained, it is respectfully requested that the Examiner explain why, based on the facts of this case, he believes that the preamble is non-limiting **in this particular case**.

Contrary to the Examiner’s position, the Federal Circuit has made clear that limitations in the preamble of a claim are limiting when they are relied upon by limitations in the body of the claim for “antecedent basis,” i.e., where the claim introduces in the preamble a term that is later recited in the claim body. E.g., NTP, Inc. v. Research in Motion, Ltd., 418 F.3d 1282, 1306, 75 USPQ2d 1763, 1781 (Fed. Cir. 2005) (“Because these limitations of claim 1 ... derive their antecedent basis from the claim 1 preamble and are necessary to provide context for the claim limitations, the use of these limitations in the preamble limits the claim.”); Eaton Corp. v. Rockwell Int’l Corp., 323 F.3d 1332, 1339, 66 USPQ2d 1271, 1276 (Fed. Cir. 2003) (“When

limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed combination.”).

This same reasoning has also been adopted by the BPAI. In *Ex parte Link* Appeal No. 2010-003339 (BPAI June 29, 2010) (non-precedential), the preamble of claim 1 recited “acrylate monomer,” and the body of the claim recited, “the monomer.” In reversing the Examiner’s rejection, the tribunal stated, “[s]ince for proper antecedent basis ‘the monomer’ must be the ‘acrylate monomer,’ there is no reasonable interpretation of the claim which does not require acrylate monomer formation.”

In each of independent claims 1, 21, 41, 63, 80, and 97, the body of the claim refers back to the content address recited in the preamble. Thus, the limitations in the preamble describing the content address must be given patentable weight.

For example, in claim 1, the preamble recites, “[a] method of accessing a unit of data stored in a content addressable storage environment in which the unit of data is accessible by a content address that is based, at least in part, upon at least a portion of the content of the unit of data.” The body of the claim recites, *inter alia*, “in response to receipt of the request, determining on which one of the plurality of storage clusters the unit of data is stored **based on the content address of the unit of data.**” As such, “**the content address,**” recited in the body of claim 1, refers to back to “a content address that is based, at least in part, upon at least a portion of the content of the unit of data,” in the preamble. Thus, “the content address” recited in the body of the claim must be interpreted to mean a content address that is based, at least in part, upon at least a portion of the content of the unit of data.”

The limitation in the preamble of claim 1 that recites that the content address is based, at least in part, upon at least a portion of the content of the unit of data is not a statement of purpose or a statement of intended use. Rather, it is a limitation describing characteristics of the content address that is recited in the body of the claim.

In view of the discussion above, it should be appreciated that the limitation in each of independent claims 1, 21, 41, 63, 80, and 97 that recites that the content address for a unit of data is “based, at least in part, upon at least a portion of the content of the unit of data,” must be given patentable weight.

As neither Heil and Nakayama discloses or suggests the use of a content address for a unit of data that is based, at least in part, upon at least a portion of the content of the unit of data, each of these independent claims patentably distinguishes over the asserted combination of Heil and Nakayama. Thus, it is respectfully requested that the rejection of each of these claims under 35 U.S.C. §103(a) be withdrawn.

#### **General Comments On Dependent Claims**

Each of the dependent claims depends directly or indirectly from one of the independent claims. For reasons described in detail above, each of the independent claims patentably distinguishes over the references and each of these dependent claims distinguishes over the references at least based on its dependency.

Accordingly, for at least the foregoing reasons, it is respectfully requested that the rejections of each of the dependent claims be withdrawn.

Because each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicant does not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor does Applicant concur that the basis for the rejection of any of the dependent claims is proper.

**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed, or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. E0295.70199US00 from which the undersigned is authorized to draw.

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Respectfully submitted,

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